

RESPONSE TO OFFICE ACTION

APPLICANT: Akira Osawa; SERIAL NO.: 09/293,509; AU: 3714

FILED: April 15, 1999; EXAMINER: White, C.; ATTY. DKT.: RM.HPN

Status of the Claims

Claims 1, 2, and 5-14 were present in the case during examination that resulted in the present Office Action. All of these claims remain in the case.

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Continued Examination Under 37 C.F.R. § 1.114

The Examiner states that a request for continued examination under 37 C.F.R. § 1.114, including the fee set forth in 37 C.F.R. § 1.17(e), was filed in this application after final rejection. The Examiner continues by stating that since this application is eligible for continued examination under 37 C.F.R. § 1.114, and the fee set forth in 37 C.F.R. § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. § 1.114. A pplicant's submission filed on March 31, 2003 has been entered.

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Double Patenting

The Examiner states that the Double Patenting Rejection of instant claims 1-2, and 5-14 over the claims of copending application 09/268,960 set forth in the previous office action (Paper #21) is hereby repeated and incorporated by reference. The Examiner continues by stating that the claims as amended in the instant application and as amended in copending application 09/268,960 are still not patentably distinct. According to the Examiner, this rejection can be overcome by a timely filed terminal disclaimer. However, the Examiner notes that until that terminal disclaimer is actually filed, the rejection still stands. The Examiner appreciates Applicant's notification to file a terminal disclaimer at such time as allowable subject matter is indicated.

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Claim Rejections - 35 U.S.C. § 103(a)

CLAIMS 1-2, 4-12 AND 14

Claims 1-2, 4-12 and 14 stand rejected under 35 U.S.C. § 103(a) as specifying subject matter considered by the Examiner to be obvious over United States Patent No. 5,393,057 ("Marnell II") or GB 2242300A ("Farrell"). Claim 4 previously has been canceled.

Regarding the instant claims, the Examiner states that the Marnell II or Farrell references teach a gaming machine for use by a player, the gaming machine comprising a variable display (Marnell II- Fig. 2, #22a; Farrell (Fig. 1, #2) for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game, the principal game having associated therewith a plurality of predetermined display states; a controller coupled to the variable display for causing the variable display to display the graphical information; and a secondary display (Marnell II Fig. 2, #23a) having a plurality of display areas for displaying a number of symbol images of a single kind corresponding to one of the plurality of predetermined display states displayed as a result of the principal game, the number of the symbol images of a single kind displayed in each of the display areas being increased each time that the principal game results in the one of the predetermined display states, thereby advancing a secondary game.

The Examiner concedes that the Marnell II reference or the Farrell reference is silent on the explicit disclosure of displaying only a single kind of display images, which is the feature that, according to the Examiner, Applicant argues for patentability. The Examiner continues by stating that Applicant indicates Fig. 3, display areas #6a1 and #6a3, of the instant disclosure, for teaching this feature. However, the Examiner does not understand, by looking at this figure and reading the claim language how the instant claimed invention is patentably distinct from the primary and secondary displays of the Marnell II reference or the Farrell reference. The Examiner states that the

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Marnell II reference in its Fig. 2 shows a plurality of display areas in which a number of symbol images of a single kind (see four images in display areas of #23a that show the symbol "BAR"). While Fig. 2 shows other images as well it still shows a number of symbol images of a single kind ("BAR"). Similarly, the Examiner continues, the Farrell reference shows in its Fig. 1, #6, a number of symbol images of a single kind "0."

The Examiner asserts that Applicant argues the feature as though only a single kind of image is shown in the secondary display. However, according to the Examiner, this is not what Fig. 3 of the instant disclosure shows. As the Examiner stated in the previous office actions, the gaming machine of the Marnell II reference or the Farrell reference is functionally capable of displaying a single kind of image. This is merely a matter of modifying the symbol image software. Further, the Examiner asserts that it would have been obvious to a person of ordinary skill in the art at the time of the invention to include the display of only a single kind of image in the secondary display of the gaming machine of Marnell II or Farrell in order to simplify the game and make it easier for beginning players.

CLAIM 13

Claim 13 stands rejected under 35 U.S.C. § 103(a) as specifying subject matter considered by the Examiner to be to be obvious over the Marnell II reference or the Farrell reference in view of United States Patent No. 6,004,207 ("Wilson, Jr., *et al.*") or United States Patent No. 5,848,932 ("Adams"). Regarding claim 13, the Examiner states that the Marnell II reference or the Farrell reference discloses all the limitations of the claim as discussed above. The Examiner concedes that the system of the Marnell II reference or the Farrell reference fails to disclose a multiplied payout. However, the Examiner argues that in an analogous gaming machine, the Wilson, Jr., *et al.* reference or the Adams reference discloses the multiplication of a payout value. In this regard, the Examiner

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directs Applicant's attention to the Wilson, Jr., *et al.* reference abstract and the Adams reference abstract. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in the Marnell II reference or the Farrell reference in order to provide multiplied payouts in slot machines to increase players' interests and financial reward in the game.

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Examiner's Response to Applicant's Prior Remarks

The Examiner states that Applicant argued that the Marnell II reference or the Farrell reference does not teach the feature of a plurality of secondary display areas for displaying a number of a single kind of symbol images. Applicant, according to the Examiner, seems to be describing this feature in the arguments as the display of only a single kind of symbol images. However, this is not what is believed by the Examiner to be claimed and this is not what is understood by the Examiner to be illustrated in Fig. 3, which Applicant asserts teaches this feature. The Examiner can see no patentable distinction between the cited prior art of the the Marnell II reference or the Farrell reference and the instant claims and Fig. 3 regarding the feature of the display of a single kind of image (please see the above claim rejections). Therefore, the claim rejections over the cited prior art remain.

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Applicant's Response

Applicant respectfully asserts that independent claim 1, which is the only independent claim in the case, specifies subject matter that is not taught or suggested by any combination of the Marnell II, Farrell, Wilson, Jr. *et al.*, and Adams references. More specifically, independent claim 1, as amended herein, specifies:

A gaming machine for use by a player, the gaming machine comprising:

a variable display for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game, the principal game having associated therewith a plurality of predetermined display states, the predetermined display states corresponding to predetermined combinations of the graphical elements of the principal game;

a controller coupled to said variable display for causing said variable display to display the graphical information; and

a secondary display having a plurality of display areas each for displaying a plurality of a corresponding predetermined single kind of symbol image, each such predetermined single kind of symbol image corresponding to a respectively associated one of the plurality of predetermined display states displayed as a result of the principal game, the number of the corresponding predetermined single kind of symbol images displayed in each of the display areas being increased each time that the principal game results in the associated one of the predetermined display states, thereby advancing a secondary game and providing indication of the frequency of appearance of the associated one of the plurality of predetermined display states.

Applicant incorporates herein by reference the arguments presented in the prior communication (filed 31 March 2003, according to the Examiner). In addition, claim 1 has been amended, without prejudice, to specify the present invention with greater precision to enhance its understandability. The foregoing notwithstanding, Applicant presents herein a discussion wherein sub-phrases of the "secondary display" clause of amended independent claim 1 are compared to the cited prior art to establish that such prior art does not teach or suggest the claimed invention.

A first portion of the "secondary display" clause of amended independent claim 1 reads as follows:

a secondary display having a plurality of display areas each for displaying a plurality of a corresponding predetermined single kind of symbol image, each

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such predetermined single kind of symbol image corresponding to a respectively associated one of the plurality of predetermined display states displayed as a result of the principal game, ...

THE MARNELL II REFERENCE

This reference shows a secondary display having a bingo matrix (#51) that corresponds to the display area for displaying plural kinds of images necessary for a secondary game. However, the Marnell II reference does not disclose or suggest a plurality of secondary display areas for displaying a number of a single kind of symbol images corresponding to one of the plurality of predetermined display states displayed as a result of the principal game. More specifically, the presentation of a predetermined poker hand will result in the selection of a space in the bingo matrix (the analogous secondary display). Thus, for example, if a predetermined poker hand (a principal game state) is presented in the principal display, a space is selected in the bingo matrix. If the same hand (the same principal game state) were to be repeated in the principal game, a different space is selected in the bingo matrix. Therefore, in the system of the Marnell II reference, a repetition of a principal game state will not, and in fact cannot, result in a repetition of the "corresponding predetermined single kind of symbol image," as claimed in the present case, because the system of the Marnell II reference will cause a different space in the bingo matrix to be selected for each such repetition in the principal game.

THE FARRELL REFERENCE

The Farrell reference teaches, as shown in Fig. 2 thereof, a secondary display having a second reel display (#22) and a matrix display (#23). In the system of the Farrell reference, the "principal" display will show three symbols on a winning line, three additional symbols above the winning line, and three further symbols below the winning line. Thus, the principal display of the reference shows a 3×3 matrix (21) with each spin of the reels of the principal game. In the game of Fig. 2 of the

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Farrell reference, the appearance of a predetermined image, such as "V" 28 or shield 29 in the principal display, is transposed to a corresponding location on the matrix 23 of the secondary game. Thus, as shown in Fig. 2 of the reference, the "V" 28 on the lower left of the principal display 21 is transposed as "V" 21' of matrix 23. Similarly, shield 29 in the upper right corner of principal display 21 is transposed to upper right corner 29' of matrix 23. This form of straightforward transposition of symbol locations is not suggestive of the claimed invention where the accumulation of symbols in the respective display areas of the secondary display is responsive to the game states of the principal game (*i.e.*, "predetermined combinations of the graphical elements of the principal game," as claimed in amended independent claim 1). This aspect of the present invention is supported in the present specification at page 16, lines 9 to 12, where it is stated that "the secondary game is executed only when one of the patterns of the principal game performed by the variable display (*i.e.*, combinations of the symbols such as "7-7-7" and others) is one that has been predetermined from all patterns to execute an indication for the secondary game stands in the central winning line in display windows 3L, 3C, 3R as stop pattern." (Emphasis Added)

The transposition system of the Farrell reference does not teach or suggest that each secondary display area is associated with one kind of images (#28' or #29') or that each of the plural display areas displays the number of the single kind of symbol images that correspond to one of the plurality of predetermined display states displayed as a result of the principal game, as claimed.

In view of the foregoing, neither the Marnell II reference or the Farrell reference teach or suggest a "secondary display having a plurality of display areas each for displaying a plurality of a corresponding predetermined single kind of symbol image, each such predetermined single kind of symbol image corresponding to a respectively associated one of the plurality of predetermined display states displayed as a result of the principal game," particularly where the display states

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correspond to predetermined combinations of the graphical elements of the principal game, as claimed.

Amended independent claim 1 additionally states in its “secondary display” clause, as follows:

... the number of the corresponding predetermined single kind of symbol image displayed in each of the display areas being increased each time that the principal game results in the associated one of the predetermined display states, thereby advancing a secondary game and providing indication of the history of appearance of the associated one of the plurality of predetermined display states.

THE MARNELL II REFERENCE

The bingo matrix (#51) that corresponds to the display area for displaying plural kinds of images necessary for a secondary game cannot, as previously stated, provide the claimed display for a “corresponding predetermined single kind of symbol image,” (Emphasis Added) as claimed. Consequently, there cannot be any “increase” of the single kind of symbol image irrespective of whether the principal game achieves any predetermined game state. Finally, the bingo matrix of the Marnell II reference provides no indication of the history of appearance of any predetermined display state. In view of the foregoing, the Marnell II reference fails even to suggest any aspect of the “secondary display” clause of amended independent claim 1.

THE FARRELL REFERENCE

As previously noted, the Farrell reference teaches the transposition of certain symbols to corresponding positions in a matrix display (23 of Fig. 2, or 6 of Fig. 1). As is the case with the Marnell II reference, the Farrell reference does not teach or suggest the claimed display for a “corresponding predetermined single kind of symbol image.” More specifically, each location on 3×3 matrices 6 or 22 of the Farrell reference can display any one of multiple symbols. In addition, there cannot be any “increase” of the single kind of symbol image irrespective of whether the principal

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game achieves any predetermined game state. This is self-evident from the fact that the transposition of symbols to the matrix is not responsive to the game states of the principal game, but instead merely reflects the location of certain symbols on the principal display. Moreover, the 3×3 matrices 6 or 22 of the Farrell reference provide no indication of the history of appearance of any predetermined display state. In view of the foregoing, the Farrell reference fails to teach or suggest any aspect of the "secondary display" clause of amended independent claim 1.

In summary, the Marnell II or Farrell references do not teach the above-enumerated features of the claimed invention. Accordingly, the amended claims specify subject matter that is not taught or suggested by any combination of the Marnell II and Farrell references.

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CLAIM 13

With respect to claim 13, it is noted once again that this is a dependent claim based on independent claim 1. Accordingly, the subject matter of claim 13 includes all of the above features that, as noted, are not disclosed or suggested in the Marnell II or Farrell references, or in the secondarily applied Wilson or Adams references. Therefore, even though the Wilson and Adams references are asserted by the Examiner as disclosing the multiplied payouts in slot machines, these references do not teach anything that would render the arguments set forth hereinabove in support of the patentability of independent claim 1 not to be persuasive.

Claims 2 and 5-14 all depend from amended independent claim 1, and therefore contain all of the limitations therein. Accordingly, these claims are believed to be in allowable condition for the reasons set forth herein in regard of independent claim 1. Accordingly, it is respectfully asserted that the Examiner's rejection of claims 1, 2, and 5-14 under 35 U.S.C. § 103(a) has been overcome.

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No New Matter Has Been Introduced

Applicant respectfully asserts that the amendments presented herein do not constitute new matter and will not require any additional search or consideration. More specifically, the specification that the predetermined display states are responsive to predetermined combinations of the graphical elements of the principal game has been in the specification at page 16, lines 9 to 12, since the filing of the case. This portion of the specification has served to define the "predetermined display states." In addition, the specification in the claim that the secondary display provides indication of the history of appearance of the associated one of the plurality of predetermined display states has also been present in the case since the time of filing. See, for example, page 5, lines 17 to 21, where it is stated that "the player can enjoy the secondary game like a "race game" in which the accumulation of the respective symbol images compete to reach right-hand terminals of each display areas, which are each assumed to be a goal. The secondary game has an aspect of a "race game," as mentioned above, and additionally provides an indication of the history of appearance of the predetermined states of the primary game."

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Conclusion

In view of the foregoing, it is respectfully requested that the Examiner reconsider the present application, allow the claims, and pass the application for issue. If the Examiner believes that the prosecution of this case can be expedited by a telephone interview, the Examiner is requested to call attorney for Applicant at the telephone number indicated hereinbelow.

Respectfully submitted,



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Annexure 1 - Claims Rewritten to Show Amendments

Please amend the claims as follows:

1. (Currently Amended) A gaming machine for use by a player, the gaming machine comprising:

a variable display for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game, the principal game having associated therewith a plurality of predetermined display states, the predetermined display states corresponding to predetermined combinations of the graphical elements of the principal game;

a controller coupled to said variable display for causing said variable display to display the graphical information; and

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a secondary display having a plurality of display areas each for displaying a number plurality of a corresponding predetermined single kind of symbol images image, the each such predetermined single kind of symbol images image corresponding to a respectively associated one of the plurality of predetermined display states displayed as a result of the principal game, the number of the corresponding predetermined single kind of symbol images image displayed in each of the display areas being increased each time that the principal game results in the associated one of the predetermined display states, thereby advancing a secondary game and providing indication of the history of appearance of the associated one of the plurality of predetermined display states.

2. (Currently Amended) The gaming machine of claim 1, wherein the secondary game is completed when any one of said the display areas of said secondary display is filled with the plural number a predetermined number of the corresponding predetermined single kind of symbol images image.

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3. (Canceled)

4. (Canceled)

5. (Currently Amended) The gaming machine of claim ~~4~~ 2, wherein an award is given to a player when ~~said the~~ secondary game is completed.

6. (Currently Amended) The gaming machine of claim 1, wherein a respective predetermined values are allotted value is assigned to said each display area of said secondary display areas, respectively.

7. (Currently Amended) The gaming machine of claim ~~6~~ 5, wherein the award given to the player completion of the secondary game is responsive to at least one of the display areas of said secondary display becomes filled with the corresponding predetermined single kind of symbol image the particular symbol images displayed as filling the respectively associated one of said display areas.

8. (Currently Amended) The gaming machine of claim 5, wherein said controller is coupled to said secondary display and executes a reset operation of said secondary display when ~~said the secondary game is completed.~~

9. (Currently Amended) The gaming machine of claim ~~6~~ 8, wherein said controller executes a reset operation of said secondary display, after any one of said the display areas of said secondary display has been filled with the corresponding predetermined single kind of symbol images image.

10. (Currently Amended) The gaming machine of claim 9, wherein the display area that is filled with the corresponding predetermined single kind of symbol images image is cleared to a blank condition in response to the execution of the reset operation.

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11. (Currently Amended) The gaming machine of claim 9, wherein the plurality of display areas of said secondary display is cleared to a blank condition in response to the execution of the reset operation.

12. (Currently Amended) The gaming machine of claim 9, wherein said controller is arranged to perform a selection between a first reset operation for clearing only exclusively the display area of said secondary display that is filled with the corresponding predetermined single kind of symbol images image to a blank condition, and a second reset operation for clearing all of said the display areas of said secondary display to a blank condition.

13. (Previously Amended) The gaming machine of claim 9, wherein said secondary display is further provided with an allotment display portion for indicating a first value representing an allotment given to a player by the secondary game for each kind of symbol image, the first value being converted to a new value in response to a selectable one of multiplication and augmentation of the first value by a predetermined number after the reset operation.

14. (Original) The gaming machine of claim 1, wherein the principal game includes a selectable one of a slot game and a poker game.